

Application No.: 10/091080

Case No.: 57080US002

Remarks

Claims 1-18 are pending. Claim 19 has been added. Support for new claim 19 can be found, for example, at page 2, lines 12-17 and the original claims.

§ 112 Rejections

Claims 1-18 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner objects to the term "superabrasive" as unclear. However, the term "superabrasive" has been used extensively in the abrasive art. (See e.g. U.S. Patent Numbers 6,634,929 and 6,416,560.) Additionally, the present application gives the specific examples of superabrasives, including cubic boron nitride and diamonds. (See page 3, lines 25-26 of the application as filed.) Therefore, the term superabrasive is not unclear.

In summary, Applicants submit that the rejection of claims 1-18 under 35 USC § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 102 Rejections

Claims 1-10 and 13-16 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bruxvoort et al. (US 5,958,794).

The Examiner states that the claims are product by process, and the resulting final product will not contain any solvent or dispersant. However, the Examiner's characterization of the resulting product is in error. The resulting product in the present application contains the dispersant.

Dispersants are non-volatile under the conditions used to coat and cure the abrasive coating. For example, the dispersant Solsperse 24000, which is exemplified, has a data sheet indicating that the dispersant does not boil, but decomposes at 250 °C. Bruxvoort teaches, in it General Procedures for Making the Abrasive Articles, to heat only to 115.5 °C. (See e.g. Bruxvoort at Col. 49, line 35 through col. 51, line 34.) Therefore, the Examiner's statement that the dispersant is not in the final product is an over-representation.

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The rejection of claims 1-10 and 13-16 under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bruxvoort et al. has been overcome and should be withdrawn.

§ 103 Rejections

In order to present a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claims 11-12 stand rejected under 35 USC § 103(a) as being unpatentable over Bruxvoort. Claims 11 and 12 both depend from claim 1. As stated above, Bruxvoort fails to teach or suggest all the claim limitations of claim 1. Therefore, Bruxvoort additionally fails to teach or suggest all the claim limitations of claims 11 and 12.

The rejection of claims 11-12 under 35 USC § 103(a) as being unpatentable over Bruxvoort has been overcome and should be withdrawn.

Claims 17-18 stand rejected under 35 USC § 103(a) as being unpatentable over Bruxvoort in view of Chen et al. (US 6,048,677).

However, the Examiner provides no motivation to place the dispersant taught in Chen into the dispersion taught in Bruxvoort. Bruxvoort makes no mention that any different dispersion would be beneficial. Therefore, the Examiner has not met the initial burden to show a *prima facie* case of obviousness with respect to claims 17 and 18.

The rejection of claims 17-18 under 35 USC § 103(a) as being unpatentable over Bruxvoort in view of Chen et al. has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-19, at an early date is solicited.

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December 24, 2003

Date

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